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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SWARTZ, RODNEY P

ART UNIT

PAPER NUMBER

1645

MAIL DATE

DELIVERY MODE

04/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,718	Applicant(s) LIU ET AL.	
	Examiner Rodney P. Swartz, Ph.D.	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-29 is/are rejected.
- 7) ☒ Claim(s) 9, 13, 25 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' Preliminary Amendment, received 18 October 2004, is acknowledged. Claims 5, 6, 7, 8, 10, 11, 12, 13, 17, 19, 20, and 23 have been amended. Claim 22 has been canceled.
2. Claims 1-21 and 23-29 are pending and under consideration.

Specification

3. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. There is no priority statement at the beginning of the specification claiming benefit of the prior documents.

4. The disclosure is objected to because of the following informalities:

Page 1, line 16, "Baldwins" should be "Baldwin".

Page 8, line 18, "duplicated" should be "duplicate".

Page 14, lines 12-13, contain an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Page 15, lines 23-30, contain an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Art Unit: 1645

Page 16, lines 1-4, contain an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Page 18, line 20, "treatmentment" should be "treatment".

Appropriate correction is required.

Claim Objections

5. Claim 9 is objected to because of the following informalities: line 2, "Mycobacterium tuberculosis" should be in italics. Appropriate correction is required.
6. Claim 13 is objected to because of the following informalities: line 2, "Mycobacterium tuberculosis" should be in italics. Appropriate correction is required.
7. Claim 25 is objected to because of the following informalities: line 2, "Mycobacterium" should be in italics. Appropriate correction is required.
8. Claim 28 is objected to because of the following informalities: line 1, "Mycobacterium bovis" should be in italics; line 2, "Mycobacterium" should be in italics. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1645

10. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 all recite "A live recombinant *Mycobacterium bovis*-BCG strain comprising a nucleic acid capable of expression" wherein said nucleic acid encodes specific proteins or consists of specific sequences.

It is unclear what is the source of the "nucleic acid capable of expression". Is the nucleic acid from other bacteria (heterologous), or part of the recombinant strain (homologous).

11. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is drawn to a live recombinant bacterium comprising a nucleic acid capable of expression. The claim also lists sequences in pairs. It is unclear if the claim is only claiming nonspecific nucleic acid or the specific sequences listed.

12. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by "MYCOBACTERIUNA BOVIS-BCG".

13. Claims 21, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1645

The claim is designated as (Original), but the claim comprises underlined material (or serine). It is unclear what is the significance of the underlining. This is usually reserved for showing amended material.

Claims 23 and 24 are dependent claims, but do not clarify the issue.

14. Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 is a method for inhibiting the growth of *Mycobacterium bovis*-BCG comprising obtaining a sample comprising *Mycobacterium* and culturing the sample in a selective media.

It is unclear how one cultures *M. bovis*-BCG if one obtains a sample comprising any other *Mycobacterium*.

15. Claims 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 is a method of culturing *Mycobacterium bovis*-BCG comprising obtaining a sample comprising *Mycobacterium* and culturing the sample in a differential media.

It is unclear how one cultures *M. bovis*-BCG if one obtains a sample comprising any other *Mycobacterium*.

16. Claims 21 and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21, 23, and 24 are drawn to a "media" composition. It is unclear if the composition is just one "medium" or several different "media".

Art Unit: 1645

Claims 25-29 are drawn to methods of culturing a *Mycobacterium* in selective or differential "media". It is unclear if the *Mycobacterium* are being cultured in just one "medium" or several different "media".

17. Claims 8 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are drawn to a vaccine or immunogenic composition comprising a live recombinant *Mycobacterium bovis*-BCG strain for treatment or prophylaxis of a mammal against challenge by mycobacteria.

It is unclear which mycobacteria the vaccine is to provide treatment or prophylaxis against, i.e., specific species or all of the species of mycobacteria.

Conclusion

18. No claims are allowed.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Wednesday from 9:00 AM to 7:30 PM EST. Thursday is the examiner's work at home day.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Shannon Foley, can be reached on (571)272-0898.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1645

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rodney P. Swartz, Ph.D./

Primary Examiner, Art Unit 1645

March 29, 2008